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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/990,343 | 11/23/2001 | Takayuki Iijima | 041465-5129 | 2295 |
| 9629 | 7590 | 10/25/2004 | EXAMINER | |
| MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 | | | DINH, TAN X | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2653 | |

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|---------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/990,343 | IIJIMA ET AL. |
| | Examiner | Art Unit |
| | TAN X. DINH | 2653 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 9-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/05/03</u> . | 6) <input type="checkbox"/> Other: _____ |

1) Applicant's election of Group C (claims 9-18) in the reply filed on 8/09/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2) The preliminary amendment filed 8/09/2004 is acknowledged. Claims 1-8 and 19-24 have been canceled.

3) The I.D.S filed 8/05/2003 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

4) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested.

**APPARATUS CAPABLE OF EDITING MANAGEMENT INFORMATION ON
OPTICAL RECORDING MEDIUM.**

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

6) (e) the invention was described in:

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7) Claims 9 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by IJICHI et al (6,542,445).

IJICHI et al discloses an information editing apparatus for editing management information to be recorded on an information storage medium, the management information (Fig.7, TOC) including track number (Fig.7, TRK1-TRK5) information imparted to one track and group management information (Fig.7, Play-list Table) for managing one or a plurality of tracks as one group, as claimed in claim 9,

Wherein when an editing instruction is issued in order to change a logical position of track belonging to one group, the correspondence relationship of track number information and group management information is automatically edited in accordance with a new logical position of track (Fig.7, Play-lists PL1 and PL2). In this case, the track number of TRK1-TRK5 changes logical position on play-list PL1 and PL2 and the correspondence relationship of track number information and group management

information automatically edited according to new logical position of tracks TRK1-TRK5).

As to claim 18, IJICHI et al shows when an editing instruction is issued in order to group-manage a track which is not under group management, a new group is created, the track is allocated to created group, and a track number imparted to a track which is allocated to new group and is not under group management is changed (Fig.7, the group management is TOC with tracks TRK1-TRK5 in sequence track number 1-5. The new group is created (play-list PL2) and the track numbers impart to new group (play-list PL2) are changed (1=TRK5, 2=TRK4, 3=TRK3, 4=TRK2, etc.,)).

8) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and

invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10) Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over IJICHI et al (6,542,445).

IJICHI et al discloses an information editing apparatus for editing management information to be recorded on an information storage medium, the management information (Fig.7, TOC) including track number (Fig.7, TRK1-TRK5) information imparted to one track and group management information (Fig.7, Play-list Table) for managing one or a plurality of tracks as one group as claimed in claims 13 and 14, except to specifically show the track number information is changed when tracks from one group imparts to another group and vice versa. It would have been obvious to someone within the level of skill in the art at the time of the invention was made to change the track number when imparts from one group to another group in IJICHI et al's editing apparatus as claimed, the rationale is as follows:

in figure 7, IJICHI et al teaches that when creates a group (play-list) from a storage medium, the track number information imparted to track remaining in one group and track number information imparted to track caused to belong to another group is changed depending on the layout of that particular group (figure

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7, the track number information (figure 7, number 1,2,3, .. etc) on one group (play-list) when imparts to another group is changed, for example, TRK3 has track number information is 1 on PL1, when impart to PL2 has track number information changes to 3.

Obviously, one of ordinary skill in the art at the time of the invention was made would have been motivated to change the track number information in IJICHI et al's editing apparatus when impart from one group to another group and vice versa.

As to claim 17, it would have been obvious to change the track number information when integrate a plural groups into one group as claimed because: as indicated above, the track number information are changed when the tracks impart from one group to another group and vice versa, therefore, the track number information would also be changed when integrate a plurality of groups into one group since the number of tracks on one group is different (more or less tracks) with the number of tracks before integrated.

As to claim 10, IJICHI et al shows the new logical position is included in an exist group and existing group is divided into a plurality of groups (Fig.7, the existing group (TRK1-TRK5) is managed by management information (TOC) and divides into two group play-list PL1 and PL2.

As to claim 11, IJICHI et al shows group information is imparted to a plurality of groups (Fig.7, group include tracks TRK1-TRK5 imparts to groups PL1 and PL2).

As to claim 12, IJICHI et al shows the same group information is imparted to a plurality of groups (Fig.7, group include tracks TRk1-TRK5 imparts to groups PL1 and PL2).

As to claims 15 and 16, it would have been obvious to someone within the level of skill in the art at the time of the invention was made to specify track number information and group information in editing system since this technique are old and widely used in the art as admitted by applicant in the specification, pages 3-4.

11) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See form PTO-892 attached herein).

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM .

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER
October 22, 2004